

By



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,208	08/01/2001	Marc E. Fusco	020366-079300US	5749

20350 7590 06/14/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

HAROLD, JEFFEREY F

ART UNIT	PAPER NUMBER
----------	--------------

2644

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,208

Applicant(s)

FUSCO, MARC E.

Examiner

Jefferey F. Harold

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1-16, 19 and 20** are rejected under 35 U.S.C. 102(b) as being anticipated by Shaffer et al. (United States Patent 5,999,599), hereinafter referenced as Shaffer.

Regarding **claim 1**, Shaffer discloses a system and method for enhanced caller name alerting. In addition, Shaffer discloses a method for alerting a user at a terminal location of an incoming phone call, the method comprising steps of: receiving a criterion manually entered by the user before the incoming phone call is placed; receiving notification of the incoming phone call with an identifier associated with the incoming phone call; detecting the identifier associated with the incoming phone call; correlating the identifier with the pre-recorded voice announcement using the criterion; and playing the pre-recorded voice announcement at the terminal location as disclosed at column 3, line 50 through column 4, line 49 and exhibited in figures 1 and 2.

Regarding **claim 2**, Shaffer discloses everything claimed as applied above (see claim 1), in addition, Shaffer discloses a step of receiving the pre-recorded voice announcement for the incoming phone call, wherein the pre-recorded voice

announcement is received from a point geographically separate from the terminal location, column 3, line 50 through column 4, line 49 and exhibited in figures 1 and 2.

Regarding **claim 3**, Shaffer discloses everything claimed as applied above (see claim 1), in addition, Shaffer discloses wherein the step of correlating the identifier comprises the following step correlating a phone number with a pre-recorded voice announcement, as disclosed at column 3, line 50 through column 4, line 49 and exhibited in figures 1 and 2.

Regarding **claim 4**, Shaffer discloses everything claimed as applied above (see claim 1), in addition, Shaffer discloses recording the pre-recorded voice announcement, as disclosed at column 3, line 50 through column 4, line 49 and exhibited in figures 1 and 2.

Regarding **claim 5**, Shaffer discloses everything claimed as applied above (see claim 4), in addition, Shaffer discloses a step of storing the pre-recorded voice announcement with consumer phone equipment, as disclosed at column 3, line 50 through column 4, line 49 and exhibited in figures 1 and 2.

Regarding **claim 6**, Shaffer discloses everything claimed as applied above (see claim 1), in addition, Shaffer discloses a step of interrupting a phone call to play the pre-recorded voice announcement, as disclosed at column 3, line 50 through column 4, line 49 and exhibited in figures 1 and 2.

Regarding **claim 7**, Shaffer discloses everything claimed as applied above (see claim 1), in addition, Shaffer discloses a step of playing the pre-recorded voice

announcement with an earpiece, as disclosed at column 3, line 50 through column 4, line 49 and exhibited in figures 1 and 2.

Regarding **claim 8**, Shaffer discloses everything claimed as applied above (see claim 1), in addition, Shaffer discloses a computer-readable medium having computer-executable instructions for alerting the user of the incoming phone call, as disclosed at column 6, line 1 through column 7, line 52 and exhibited in figure 7.

Regarding **claim 9**, Shaffer discloses a method for alerting a user of an incoming phone call, the method comprising the steps of: recording a voice announcement to create a pre-recorded voice announcement; receiving a selection that helps correlate the pre-recorded voice announcement to an identifier, wherein the selection is manually entered by the user prior to the incoming phone call; receiving notification of the incoming phone call that indicates the identifier associated with the incoming phone call; detecting the identifier associated with the incoming phone call; correlating the identifier with the pre-recorded voice announcement using the selection; and playing the pre-recorded voice announcement, as disclosed at column 3, line 50 through column 4, line 49 and exhibited in figures 1 and 2.

Regarding **claim 10**, Shaffer discloses everything claimed as applied above (see claim 9), in addition, Shaffer discloses a step of receiving the pre-recorded voice announcement for the incoming phone call from a first location across a wide area network from a second location of the user, as disclosed at column 3, line 50 through column 4, line 49 and exhibited in figures 1 and 2.

Regarding **claims 11-16, 19 and 20**, they are interpreted and thus rejected for the reasons set forth above in the rejection of claims 1-10.

Response to Arguments

2. Applicant's arguments with respect to claims 1-16, 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F. Harold whose telephone number is 571-272-7519. The examiner can normally be reached on Monday - Friday 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh H. Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jefferey F Harold
Examiner
Art Unit 2644



JFH
June 10, 2005